

In re Patent Application of:
THOMSON ET AL.
Serial No. 09/658,509
Filed: **SEPTEMBER 8, 2000**

REMARKS

By this amendment, independent Claims 1 and 11 have been amended to include features of respective dependent Claims 5 and 15 which have now been cancelled. Claims 1-4, 6-14 and 17-27 remain pending in the application.

The arguments supporting patentability of the present invention are found below.

I. The Double Patenting Rejection

The Examiner again issued a non-statutory double patenting rejection of Claims 1-27. More particularly, the Examiner notes that the claims are unpatentable over Claims 1, 3, 15, 24, 27, 31, 33, 35, 38, 40, 43, and 45 of copending Application No. 09/658,389 in view of the Roddy patent, in view of the Giard patent, and in view of the Jeshurun et al. patent (U.S. 5,165,301).

As previously discussed, Applicants maintain that the claims of the present application and the co-pending patent application are directed to patentably distinct aspects of the bicycle stem. Accordingly, it is requested that the double patenting rejection be withdrawn. Alternatively, Applicants request that the rejection be held in abeyance until the claims are otherwise in condition for allowance, at which time Applicants will submit a terminal disclaimer.

II. The Claims Are Patentable

Claims 1-27 were rejected in view of Giard or Roddy, alone, or in various combinations with Jeshurun et al. and Lai for the reasons set forth on pages 5-12 of the Office Action.

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Applicants contend that Claims 1-4, 6-14 and 16-27 clearly define over the cited references, and in view of the following remarks, favorable reconsideration of the rejections is requested.

The invention, as recited in independent Claims 1 and 11, for example, is directed to a bicycle stem and at least includes a handlebar clamping portion, having a first arcuate extent, and a handlebar clamping member, having a second arcuate extent, and cooperating with the handlebar clamping portion to clamp the bicycle handlebar therebetween. The handlebar clamping member and handlebar clamping portion each have a recess for the handlebar and a cavity in a respective medial portion of the recess to accommodate an enlarged diameter portion of the handlebar. The cavity in the recess of the handlebar clamping portion extends fully over the first arcuate extent thereof, and the cavity in the recess of the handlebar clamping member extending fully over the second arcuate extent thereof. The stem has a tubular and hollow body while the cavity of the handlebar clamping portion has an opening therein in communication with the hollow interior of the body.

Similarly, independent Claim 20 recites that the handlebar clamping member has a recess therein for the handlebar and the cavity is in the medial portion of the recess. Further, the handlebar clamping portion has a recess for the handlebar and an opening in a medial portion of the recess in communication with interior of the hollow body. The cavity in the recess of the handlebar clamping member extends fully over the arcuate extent thereof.

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The Examiner has now relied on the combination of Giard and Jeshurun et al. or the combination of Roddy, Jeshurun and Giard to allegedly meet the requirements of the claimed invention. Applicants will address each combination separately below.

As mentioned above, Claims 1, 11 and 20 set forth that the body is tubular and hollow, and that the cavity in the recess of the handlebar clamping member extends fully over the second arcuate extent thereof. With respect to the combination of Giard and Jeshurun et al., the Examiner points to Giard for the disclosure of a stem with a handlebar clamping portion and a handlebar clamping member (e.g. Figs. 4 and 5 of Giard), while pointing to Jeshurun as teaching the use of a clamp with a centered groove to accommodate an annular ridge of a stem mounting section of a handlebar. The Examiner then asserts that it would have been obvious to modify the clamping device of Giard with the cavity/centered groove of Jeshurun to arrive at the claimed invention.

However, as discussed in column 4, lines 4-6 and lines 34-37 of the Giard patent (referring to Figs. 4 and 5 of Giard, for example), a "primary advantage" of the clamping device of Giard is the use of only a single fastener 49 which is centered at the edge of the cover member 44 and the end portion 43. The Examiner's proposed modification of the Giard clamping device to include a centered cavity/groove as taught by Jeshurun would render the Giard device unsatisfactory for its intended advantage because the use of a single centered fastener would be prevented. As the Examiner is aware, if a proposed modification would render the prior art invention

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being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification (MPEP §2143).

Furthermore, with respect to the combination of Roddy, Jeshurun and Giard, the Examiner points to Roddy for the disclosure of a solid clamping device having a handlebar clamping member and clamping portion while pointing to Jeshurun as teaching the use of a clamp with a centered groove to accommodate an annular ridge of a stem mounting section of a handlebar, and while relying on Giard as teaching the use of a tubular hollow body in communication with an opening in a recess of a handlebar clamping portion. The Examiner then asserts that it would have been obvious to modify the clamping device of Roddy with the cavity/centered groove of Jeshurun, and then further modify that combination to include the hollow tubular body and opening in the handlebar clamping portion of Giard to arrive at the claimed invention.

However, as discussed in column 2, lines 14-21 of Roddy, an advantage of the Roddy clamping device is the coverage and engagement of a greater surface area of the circumference of the handlebar. The Examiner's proposed modification of the Roddy clamping device to include a tubular hollow body having in the handlebar clamping portion would render the Roddy device unsatisfactory for its intended advantage because the coverage and engagement of a greater surface area of the circumference of the handlebar would be impeded. Again, a proposed modification cannot render the prior art invention unsatisfactory for its intended purpose.

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Additionally, in Giard, the opening in the handlebar clamping portion relied upon by the Examiner is not described or discussed at all in the reference. Although, the opening is shown in Figs. 9 and 11 of Giard, the reference provides no indication of any advantages or need for the opening. Indeed, the Giard reference actually discusses the desirability of providing a uniform clamping surface by eliminating spaces or gaps in wall sections of a clamp (Col. 2).

As the Examiner is also aware, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In sum, there is simply no teaching or suggestion in the cited references to provide the combination of features as claimed. Accordingly, for at least the reasons given above, Applicants maintain that the cited references do not disclose or fairly suggest the invention as set forth in Claims 1, 11 and 20. Furthermore, no proper modification of the teachings of these references could result in the invention as claimed. Thus, the rejections under 35 U.S.C. §103 should be withdrawn.


It is respectfully submitted that independent Claims 1, 11, and 20 are patentable for the reasons detailed above. In view of the patentability of the independent claims, it is also submitted that their dependent claims, which recite yet further distinguishing features, are also patentable. These dependent claims require no further discussion herein.

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III. CONCLUSION

In view of the arguments provided above, it is submitted that all the claims are patentable. Accordingly, a Notice of Allowance is requested in due course. If any minor informalities need to be addressed, the Examiner is encouraged to contact the undersigned at the telephone number listed below.

Respectfully submitted,


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CERTIFICATE OF FACSIMILE

I hereby certify that this correspondence is being sent via facsimile no. 703-305-7687 to: DIRECTOR, U.S. PATENT AND TRADEMARK OFFICE, WASHINGTON, D.C., on this 13th day of March, 2003.

